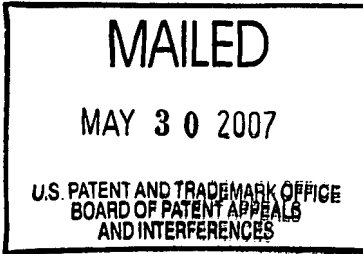


UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte MARTIN GUTFLEISCH
and
MARTIN SCHMITT-LEWEN

Application 09/923,696

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received electronically at the Board of Patent Appeals and Interferences on March 21, 2007. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being electronically returned to the examiner. The matters requiring attention prior to docketing are identified below:

An examination of the Image File Wrapper (IFW) reveals that an Appeal Brief was filed on July 8, 2005.

37 CFR § 41.37(c)(1) (2005) reads as follows:

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(i) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

....

(v) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

The “Summary of claimed subject matter” appearing on page 3 of the Appeal Brief filed July 8, 2005 is deficient because it does not map the independent claims to the specification. See § 1205.03(B) of the Manual of Patent Examining Procedure (MPEP) (Eighth Edition, Rev. 3, August 2005) which states:

(B) When the Office holds the brief to be defective solely due to appellant’s failure to provide a summary of the claimed subject matter as required by 37 CFR 41.37 (c)(1)(v), an entire new brief need not, and

should not, be filed. Rather, a paper providing a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v) will suffice. Failure to timely respond to the Office's requirement will result in dismissal of the appeal. See MPEP § 1215.04 and § 711.02(b).

Correction is required.

In addition, § 1207.02 of the Manual of Patent Examining Procedure

(MPEP) (8th Ed., Rev. 3, August 2005) states in part:

Requirements for Examiner's Answer

The examiner's answer is required to include, under appropriate headings, in the order indicated, the following items:

....

(11) Related Proceedings Appendix. Copies of any decisions rendered by a court or the Board in any proceedings identified by the examiner in the "Related Appeals and Interferences section of the answer.

Correction is required.

Finally, an Information Disclosure Statement (IDS) was filed on August 15, 2003. It is not apparent from the record whether the examiner considered the statement submitted or notified appellants regarding why their submission did not meet the criteria set forth in 37 CFR §§ 1.197 and

1.98. A communication notifying appellants of the Primary Examiner's decision is required.

Accordingly, it is

ORDERED that the application is returned to the Examiner:

- 1) for notification to appellants to submit a paper providing a revised "Summary of claimed subject matter";
- 2) for consideration of said paper;
- 3) for submission of a PTOL-90 which includes the section "(11) Related Proceedings Appendix";
- 4) for consideration of the IDS filed August 15, 2003, and written notification to appellants regarding the Primary Examiner's decision; and
- 5) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

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PJN:psb

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